

REMARKS

Applicants are grateful for the thoroughness of the examination and appreciate the opportunity to distinguish the pending claims over the prior art of record. Claims 1, 3, 5-8, 10-18, and 20-25 are pending in the subject application. Claims 1, 3, 5-8, and 10-15 are allowed. Claims 16-18, and 20-25 are presently under consideration. Currently, claims 16-18, 20, 21, 24, and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Thomas, Jr. (U.S. Patent No. 1,364,529). Claims 22 and 23 are objected to as being dependent on a rejected base claim. Consideration of non-elected species claims 2, 4 and 19 is requested under 37 CFR 1.141 as dependent from generic claims.

**Remarks Directed to the Rejection of Claims 16-18, 20, 21, 24,
and 25 under 35 U.S.C. § 103 as Unpatentable over Thomas, Jr.:**

Withdrawal of the rejection of claims 16-18, 20, 21, 24, and 25 is respectfully requested for at least the following reasons. Amendment to claim 16 distinguishes claim 16, and all claims which depend from claim 16, from the prior art. Thomas, Jr. does not teach or suggest the claimed invention. "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. 103(a) (2004). An application of 35 U.S.C. 103 requires that "the references . . . be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; . . . reasonable expectation of success is the standard with which obviousness is determined." *Hodosh v. Block Drug Co., Inc.*,

786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). In consideration of the desirability of making a modification, any modification that would “render the prior art invention being modified unsatisfactory for its intended purpose” may not be considered obvious in reference to the prior art. MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Additionally, a modification that would change the principle of operation of the prior art invention being modified may not be considered to establish a *prima facie* case of obviousness. *Id.*; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Finally, “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.” 35 U.S.C. 112 (2004).

Claim 16 is presently amended to incorporate the limit requiring the notched first end having at least one notch with a depth running parallel to the axial length of said sleeve. This amendment is fully supported by the originally filed specification and drawings as of the filing date of the subject application (*see* paragraphs 005 and 013; drawing figures 2 and 3).

The Thomas, Jr. reference does not teach or suggest a notched portion of a sleeve with a depth running parallel to the axial length of the sleeve. The “peripheral inwardly extending groove or depressed portion” in Thomas, Jr. is “adapted to fit against the edge of the opening of an outlet box.” (column II, lines 6-8; column I, lines 54-55, respectively). Thus, the Thomas, Jr. device depends on the orientation of the groove or notch being perpendicular to the axial length of the sleeve to “engage[] with the edges of the opening” so as to “bind firmly.” (column I, line 42; column II, line 73, respectively). Alteration of the orientation of the groove in the prior art to be parallel to the axial length of the sleeve would render the invention unsatisfactory for its intended purpose of binding the electrical box or wall firmly because a parallel orientation of the depth of the notch would remove the binding surface from the prior art invention. Thus, the

orientation of the groove parallel to the axial length of the sleeve cannot be considered obvious to one of ordinary skill in the art (*See In re Gordon*, 733 F.2d 900), and does not render the claims in the subject application *prima facie* obvious.

Alternatively, modifying the orientation of the notch or groove of the Thomas, Jr. invention would alter its principle of operation. The prior art invention principally operates to affix the connector “against the edge of . . . [an] opening” such as an electrical box or a wall (column I, lines 54-55). The groove formed in the peripheral end of the connector is integral and absolutely necessary for the operation of the prior art invention both functioning alone and to bind a “ring [] also provided with a grooved external surface.” (column II, lines 60-61). The presence of a similar groove on the ring disclosed in the prior art further commands the requirement of the orientation of the groove on the connector as perpendicular to the axial length of the sleeve for affixing the connector to its desired surface (the prior art’s principal operation). Modification of the orientation and depth of the groove to that of parallel to the axial length of the sleeve would eliminate the affixing power of the prior art invention. As this modification would alter, or destroy, the principle operation of the prior art invention, the modification of orienting the groove parallel to the axial length of the sleeve is not sufficient to render the claims of the subject application *prima facie* obvious. MPEP 2143.01; *In re Ratti*, 270 F.2d 810.

A sleeve with a notch with its depth running parallel to its axial length is not disclosed in the prior art, nor is this limitation obvious to one of ordinary skill in the art. Therefore, claim 16 is distinguished from the prior art. Furthermore, as a dependent claim is read to incorporate all the limitations of the claim from which it depends, 35 U.S.C. § 112, claims 17-18, 20, 21, 24, and 25 are not rendered obvious by the Thomas, Jr. reference.

In light of the above amendments and remarks, reconsideration and allowance of claims 16-18, 20, 21, 24, and 25 under 35 U.S.C. § 103 is respectfully requested.

Remarks Directed to the Objection of Claims 22-23:

Withdrawal of the objection to claims 22 and 23 is respectfully requested for at least the following reasons. Thomas, Jr. does not teach or suggest the claimed inventive process. “[A] claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.” 35 U.S.C. 112.

Claim 16, the independent claim from which claims 22 and 23 depend, has been amended to add a limitation: the notched first end having at least one notch with a depth running parallel to the axial length of said sleeve. This amendment is fully supported by the originally filed specification as of the filing date of the subject application (*see* paragraphs 005 and 013; drawing figures 2 and 3). As this amendment claims a modification that if made to the prior art would both render it inoperable for its intended purpose and change its principle of operation, claim 16 cannot be rendered *prima facie* obvious. MPEP 2143.01; *In re Gordon*, 733 F.2d 900; *In re Ratti*, 270 F.2d 810.

As the above amendment to subject claim 16 renders it no longer obvious over the referenced prior art, we respectfully request reconsideration of the objection to claims 22 and 23.

Summary

Claims 1, 3, 5-8, 10-18, and 20-25 are currently pending in this application. Consideration of non-elected species claims 2, 4 and 19 is requested. Applicant submits that claims 1, 3, 5-8, 10-18, and 20-25 are now in allowable form and directed to patentable subject matter. Reconsideration and allowance of the pending claims is solicited. Should the Examiner have any suggestions as to how to improve the form of the pending claims, he is respectfully requested to contact the undersigned attorney in charge of this application.

Respectfully submitted,



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